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09/762,532	02/08/2001	Richard Oliver		5064

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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 05/22/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/762,532

Applicant(s)

OLIVER, RICHARD

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

- 1) Acknowledgement is made of preliminary Amendment received 2/8/2001, Paper No. 6. Applicant cancels claims 1-18, and offers new claims 19-38, for consideration.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 19-37, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "the suction force" in line 7. Claim 20 recites the limitation "the step" in line 1. Claim 21 recites the limitation "the location" in line 3. Claim 24 recites the limitation "the angle" in line 1. Claim 26 recites the limitation "the feed path" in line 4; the limitation "the travel direction" in line 4; and the limitation "the smoking material deposition run" in lines 4-5. Claim 27 recites the limitation "the step" in line 1; and the limitation "the form" in line 2. Claim 29 recites the limitation "the location" in line 3. Claim 36 recites the limitation "the degree" in line 2; and the limitation "the remainder" in line 3.

There is insufficient antecedent basis for these limitations in the claims.

Claims 19, 21-23, 26, 29-31, recite the limitation "predetermined" rendering the claims indefinite. A claim is indefinite when it specifies "predetermined" temperatures,

etc., when "predetermined" according to applicant's definition merely means determined beforehand. See *Jennings et al. v. Jorgensen et al.* 84 USPQ 180.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 3) Claims 19-23, 25-27, 32, 37-38, are rejected under 35 U.S.C. 102(b) as being anticipated by Haws (EP 0 405 929 A2).

Claims 19-23, 26-27, 32, 38: Haws discloses a method for applying liquid strands containing additives to cigarette rods resulting in a cigarette product wherein the tobacco rod is surrounding the liquid strand (Abstract) extending down the length of the cigarette (col. 2, lines 15-24). In the process tobacco is blown from a chimney 10 onto an advancing perforated vacuum belt 12 causing tobacco to accumulate on the belt. A liquid strand is placed near the tobacco rod accumulating area and pumped from storage 50 through pipe 51 and out through nozzle 58. The pipe 51 is a guide that constrains the strand to the desired path. The air under suction causes the liquid extrudate to ascent and become impinged upon the tobacco for a certain distance along deposition run. As more tobacco is added it completely surrounds the liquid strand (col. 3, line 25 to col. 5, line 51, and Figures 1, 2, 6) into a final cigarette rod product. A variety of materials may be in the strand including flavorants and burn modifiers (col. 2, lines 36-45, and col. 6, line 45 to col. 7, line 25).

Claims 25, 37: the flow of the strand can be adjusted to any speed by the control of the pump (col. 6, lines 17-45).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 19-27, 29-32, 37-38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Haws.

Claims 19-23, 26-27, 29-32, 38: Haws discloses a method for applying liquid strands containing additives to cigarette rods resulting in a cigarette product wherein the tobacco rod is surrounding the liquid strand (Abstract) extending down the length of the cigarette (col. 2, lines 15-24). In the process tobacco is blown from a chimney 10 onto an advancing perforated vacuum belt 12 causing tobacco to accumulate on the belt. A liquid strand is placed near the tobacco rod accumulating area and pumped from storage 50 through pipe 51 and out through nozzle 58. It would have been obvious that the pipe 51 is a guide that constrains the strand to the desired path. The air under suction causes the liquid extrudate and become impinged upon the tobacco for a certain distance along deposition run. It would have been obvious that the air suction flow would cause the strand to ascend toward the vacuum belt. As more tobacco is added it completely surrounds the liquid strand (col. 3, line 25 to col. 5, line 51, and Figures 1, 2,

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6) into a final cigarette rod product. A variety of materials may be in the strand including flavorants and burn modifiers (col. 2, lines 36-45, and col. 6, line 45 to col. 7, line 25). The specific constraining distance is an obvious matter of apparatus design choice selected to produce the desired characteristics in the desired final product.

Claim 24: the strand is under the suction effect of the vacuum, however, it would have been obvious that the angle of ascent of the strand would be minimal, not more than 5 degrees.

Claims 25, 37: the flow of the strand can be adjusted to any speed by the control of the pump (col. 6, lines 17-45).

#### ***Allowable Subject Matter***

5) Claims 28, 33-36, would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that the cited prior art does not show a method of incorporating a fibrous element in a smoking material rod, said method including the step of: feeding a fibriform in the form of a sequence of discrete fibroform elements (claim 28); providing a guide in a configuration such that the fibriform path ascends towards a deposition run (claim 33); enlarging the flow path of the smoking material in the vicinity said guide (claim 35); modifying the degree of suction (claim 36).

**Conclusion**

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern  
Patent Examiner  
Art Unit 1731

May 17, 2002



**CHRISTOPHER A. FIORILLA  
PRIMARY EXAMINER  
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